

### **REMARKS/ARGUMENTS**

Reconsideration of this Application and entry of this Amendment is respectfully requested.

In the Office Action, the Examiner indicated that Applicant's previously filed appeal brief was persuasive and the previously stated grounds for rejection were withdrawn. Applicant thanks the Examiner for this.

Also in the Office Action, the Examiner stated new grounds for rejection of claims 53-58 and 61-63 as follows:

- Independent claim 53 was rejected under 35 U.S.C. §102 as being anticipated by United States Patent No. 5,800,450 (Lary et al);
- All claims 55-58 and 61-63 were rejected under 35 U.S.C. §103 as being obvious over WO 93/15664 (Makower et al) in view of one or more secondary references.

By the foregoing amendment, the "Related Applications" section of the application has been amended to accurately recite the complete chain of priority claimed at the time of filing of this application. No petition is seen to be required for entry of this amendment as priority to the copending applications was duly claimed in the transmittal documents that accompanied filing of this application and this amendment is being presented merely to complete and clarify the lineage of those copending applications to which priority was duly claimed.

Also, by the foregoing amendment, independent claim 53 has been amended to clarify certain aspects of the claimed invention. No new matter has been added. As amended, independent claim 53 recites a system that comprises an elongate flexible catheter body that has a side wall and a lumen and is advanceable through the vasculature into a blood vessel lumen. Claim 53 also recites an opening in the side wall of the flexible catheter body and a tissue penetrating element that assumes a predetermined curved configuration and extends out of that opening in the side wall of the flexible catheter body.

35 U.S.C. §102 Rejection

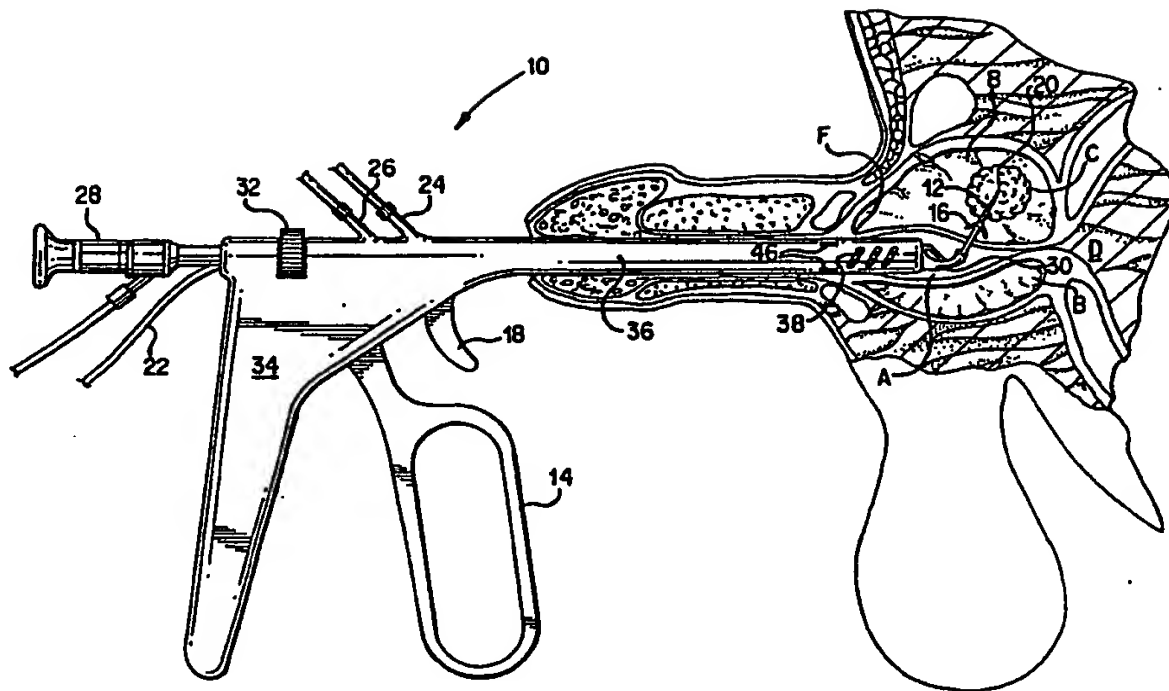
Applicant respectfully traverses the anticipation rejection over Lary et al. on grounds that Lary et al. is not prior art to claim 53. The Examiner will note that this application claims priority to several copending applications. Each of those copending applications claims priority to, and expressly incorporates by reference, two provisional applications that were filed prior to the October 3, 1996 filing date of Lary et al. Namely, those provisional applications are United States Provisional Application Serial No. 60/005,164 filed Oct. 13, 1995 and 60/010,614 filed Feb. 2, 1996. Both of these provisional applications contained written description and drawings which are fully enabling of independent claim 53.

Thus, independent claim 53 is entitled to the benefit of the October 13, 1995 filing date. Accordingly, Lary et al., which was filed on October 3, 1996, does not constitute prior art to independent claim 53. On this basis, withdrawal of the stated rejection over Lary et al. is requested.

35 U.S.C. §103 Rejections

Independent claim 53, as presently amended, clearly distinguishes over PCT International Publication No. WO/1993/015664 (Makower et al.) alone or in combination with any of the cited secondary references.

Makower et al. describes an apparatus and method for treating prostate disease as seen in the following figure reproduced from Makower et al.



As the Examiner will note, the Makower et al. device has a rigid shaft 36 that is advanced into the urethra in contrast to a flexible catheter body that is advanceable through the vasculature as recited in amended claim 53. Also, the cannula (12) of Makower et al. is advanced through a curved projection on the distal end of the shaft 36 and into the prostate, not through an opening in the side wall of a flexible catheter body as recited in amended claim 53. Nothing in Makower et al. describes or suggests any motivation to modify the rigid shaft 36 to make it flexible and capable of being advanced through the vasculature, nor does anything in Makower et al. describe or suggest any motivation to redesign the disclosed device such that the cannula would exit through a side opening in a flexible catheter body rather than through the curved projection on the distal end of the rigid shaft 36, as shown. Thus, Applicant respectfully submits that independent claim 53, as presently amended, also distinguishes over Makower et al. when taken alone or in combination with any other prior art of record.

### Conclusion

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge the one (1) month extension fee and any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 50-0878. If the Examiner feels that a

Application No. 09/912,122  
Amd. Dated:  
Reply to Office Action mailed April 19, 2006

telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (949) 450-1750.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "R.D. Buyan", written over a horizontal line.

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